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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SmithKline Beecham Corporation¹

Serial No. 78/023,396

Maury M. Tepper, III of Womble Carlyle Sandridge & Rice for
SmithKline Beecham Corporation.

Esther Borsuk, Trademark Examining Attorney, Law Office 116
(Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

SmithKline Beecham Corporation (applicant) applied to
register the mark CASEY (in typed form) on the Principal
Register for services ultimately identified as:

Health care analysis services, namely, providing
employers and managed care organizations information
on health care costs associated with asthma and on
cost savings associated with treatments for asthma, by
using actuarial models to estimate direct medical
costs and lost productivity costs due to asthma;
analysis services, namely, providing employers and

¹ The application was originally filed by Glaxo Wellcome, Inc.
It was subsequently assigned to SmithKline Beecham Corporation as
a result of a merger. See Reel/Frame No. 2334/0278.

managed care organizations information on health care costs associated with asthma and on cost savings associated with treatments for asthma, by using actuarial models to estimate direct medical costs and lost productivity costs due to asthma in International Class 35.

Health care consultation services in International Class 42.²

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), because the examining attorney determined that there was a likelihood of confusion between that mark and a registration for the mark CASEY (in typed form) for "educational services, namely, providing classes, seminars, and training in the field of health care" in International Class 41 and "medical research services and health care services" in International Class 42.³

After the examining attorney made the refusal final, this appeal followed.

The examining attorney argues that the marks are identical and that "applicant's health care cost analysis and health care consultation services and the registrant's health care services would be encountered by the same

² Serial No. 78/023,396, filed August 29, 2000. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

³ Registration No. 2,355,403, issued on June 6, 2000, under the provision of Section 2(f) of the Trademark Act.

purchasers and under the same circumstances." Brief at 4. The examining attorney also submitted copies of registrations to show that "health care consultation services and health care cost analysis services are marketed under the same service mark as health care services." Br. at 4. The examining attorney concluded that since the marks are identical and the services travel in the same channels of trade, confusion is likely.

Applicant makes four basic arguments in response to the examining attorney's refusal. First, applicant argues that its "business consulting services are sold in different channels of trade and sold to different types of customers than the health care services offered by Registrant in the field of ophthalmology and eye care." Brief at 3. Second, applicant's business consulting services are fundamentally different from registrant's health care services. Third, the purchasers are sophisticated and, fourth, the marks have different connotations. Brief at 3. Therefore, applicant submits that confusion is unlikely.

We affirm the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re

E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Despite applicant's argument that the marks have different commercial impressions, we note that applicant's and registrant's marks are identical. Both marks are for the identical word, "CASEY," in typed form. While applicant argues that its mark is an acronym for "Cost Analysis, Statistics & Economics for You" and registrant's mark is associated with the Casey Eye Institute, it does not change the fact that there are no differences between the two marks.

Next, we consider whether the services of the parties are related. Applicant attempts to limit registrant's services to ophthalmology and eye care services. See, e.g., "[T]he health care services in the Cited Registration relate exclusively to the field of ophthalmology and eye care and research and are offered exclusively to patients

and ophthalmologists and in connection with research conducted at the Casey Eye Institute at the Oregon Health Services University." Brief at 5⁴. We emphasize that the services identified in the registration are not limited in this way. In fact, the services are identified simply as "medical research services and health care services."

We are not at liberty to restrict a registration's identification of goods or services based on applicant's evidence of how registrant is actually using its mark. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original),

⁴ With its Brief, applicant attached three exhibits. The examining attorney objects to these exhibits. We will not consider Exhibits B and C because they were not previously made of record. 37 CFR § 2.142(d) (Exhibit A was made of record previously). In addition to the exhibits submitted with its appeal brief, applicant also submitted a list of registration numbers, classes, marks, and goods and services with its response dated April 5, 2001 (Attachment D). In the next Office action, the examining attorney noted that "applicant failed to make the registrations properly of record." Office action dated June 19, 2001, p. 3. Applicant did not submit copies of these registrations with its subsequent request for reconsideration. We will not consider these registrations because they are not properly of record. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"). In any event, most of the registrations are for unrelated goods and services.

quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

While applicant has limited its health care analysis services to the field of asthma, registrant's services and applicant's health care consultation services are not limited to any specific field of medicine. Thus, we must consider that the services rendered under the mark could include medical research, health care, and classes and training in health care relating to asthma. Registration Nos. 2,372,769; 2,277,272; 2,129,905; and 1,977,996 provide some support for the examining attorney's position that

health care services and health care consultation services are related because they show that these services often originate from the same source under the same mark. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Furthermore, the registrations of record also show that applicant's other identified services, health care analysis services, are related to registrant's services. For example, Registration No. 1,977,996 shows the same mark used in connection with managed health care services and providing statistical information on incidents of illness to determine the viability and need for educational wellness programs. Registration No. 2,433,306 shows health care services and health care utilization and review services; and Registration No. 2,251,350 is for health care services and medical cost management services for others. Applicant's health care analysis services of providing information on health care costs to estimate the direct

medical costs and lost productivity due to asthma are related to registrant's health care services because providers of health care services are also the source of services involving various medical cost and utilization management services, which would be similar to applicant's health care analysis services.

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). Furthermore, when both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive

or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Here, prospective purchasers are likely to assume that there is a relationship between registrant's health care services and applicant's health care consultation services and health care analysis services in the field of asthma. Businesses that are in the market for health care services for their employees would also be interested in health care consulting services and health care analysis services to reduce costs, improve efficiency, and encourage the good health of their employees.

Even if we assume that the purchasers of these services would be sophisticated purchasers, this fact would not eliminate the likelihood of confusion when the identical mark CASEY is used on the services of applicant and registrant. Octocom Systems, 16 USPQ2d at 1787. Even sophisticated purchasers would likely be confused when the identical marks are used on health care and health care consultation and analysis services.

Finally, to the extent that there is any doubt regarding the question of the likelihood of confusion, we must resolve this doubt in favor of the registrant and against the newcomer. Kenner Parker Toys v. Rose Art

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Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.